

C1
cancel
claim
2

providing the surface containing titanium;
eliminating substances adhered to said surface of said substrate from said surface,
said adhered substances resulting from the substrate having been subjected to machine working,
wherein said adhered substances are foreign materials, and
forming a transparent protective layer on said surface after removing said adhered
substances.

REMARKS

Claims 1-24 and 40 are pending in this application and stand rejected. Claim 1 is independent.

By this Amendment Applicant seeks to cancel claim 2 and revise claim 1 to incorporate the subject matter of claim 2, and thereby clarify the precise nature of this invention. Upon entry of this Amendment, claims 1, 3-24 and 40 will be pending, and claim 1 will remain independent.

The Rejection Under 35 U.S.C. § 112, ¶ 1

Claims 1-24 and 40 were rejected under 35 U.S.C. § 112, first paragraph, as failing to provide enabling support for the claimed invention. In particular, the Examiner asserted that although the specification was enabling for facing cases for watches made of titanium, the specification did not provide enablement for any other titanium surface, such as those for cutting tools.

This rejection is respectfully traversed on grounds the specification explicitly states at page 35 that the present invention is applicable to a wide variety of articles in addition to

SSL-DOCS11094162v1

watches, such as clocks, eyeglass frames, tiepins, cufflinks, lighters, pens, rings, necklaces, bracelets, portable phones, calculators, personal computers, measuring instruments, and so forth.

It is respectfully submitted that given the clearly articulated teachings in the specification that this invention is applicable to a wide variety of articles, including, but not limited to watches, and because the description in the specification of the processes used in this invention does not state that such processes are applicable only to watches, those skilled in the art would understand that the claimed invention covers and is fully-supported for the production of all articles, not just watches.

Applicant also respectfully submits that this rejection should be withdrawn because the M.P.E.P. does not require precise correlation between the claimed invention and the disclosure. Rather, M.P.E.P. § 2164.08, entitled "Enablement Commensurate in Scope With the Claims", reads in pertinent part:

The Federal Circuit has repeatedly held that "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). **All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to the scope of the claims.** See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Applicant respectfully submits that, given the level of knowledge and skill in the art, as exemplified by the references applied in the following rejection under 35 U.S.C. § 103, the present specification provides more than a "reasonable correlation" between the claimed invention and the disclosure, and that those skilled in the art would be able to practice the invention as claimed without the need for undue experimentation.

The M.P.E.P. holds that the enablement requirement of 35 U.S.C. § 112, ¶ 1, is satisfied where, as here, the claimed invention can be practiced without requiring those skilled in the art to engage in undue experimentation.

M.P.E.P. § 2164.01, entitled "Test of Enablement", states:

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: **is the experimentation needed to practice the invention undue or unreasonable?** That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). **A patent need not teach, and preferably omits, what is well known in the art.** (citations omitted).

* * * *

The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

M.P.E.P. § 2164.01 (emphasis added).

The M.P.E.P. addresses what constitutes undue experimentation in § 2164.01(a), entitled "Undue Experimentation Factors". One of the factors to be considered is the level of predictability in the art. M.P.E.P. § 2164.03, entitled "Relationship of Predictability of the Art and the Enablement Requirement", reads in pertinent part:

The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling.

The "predictability or lack thereof" in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. If one skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains, then there is predictability in the art. On the other hand, if one skilled in the art cannot readily anticipate the effect of a change within the subject matter to which that claimed invention pertains, then there is lack of predictability in the art. Accordingly, what is known in the art provides evidence as to the question of predictability.

* * * *

The scope of the required enablement varies inversely with the degree of predictability involved, but even in unpredictable arts, a disclosure of every operable species is not required. A **single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements.** *In re Vickers*, 141 F.2d 522, 526-27, 61 USPQ 122, 127 (CCPA 1944); *In re Cook*, 439 F.2d 730, 734, 169 USPQ 298, 301 (CCPA 1971).

(emphasis added).

The present case presents a situation where broad enablement is provided. Here, the relevant art is the surface finishing of materials, and it is respectfully submitted that, as regards the present rejection, this is a very predictable field. Those skilled in the art will recognize that a surface treatment procedure which works for a watch casing can be used without undue experimentation to process other types of articles, such as jewelry, picture frames and paperweights.

Applicant further submits that the Examiner, by citing references not specifically directed to the finishing of a watch casing, but rather, to surface treatment in general, has acknowledged that surface treatment techniques are of general applicability.

For all the foregoing reasons, favorable reconsideration and withdrawal of these rejections is respectfully requested.

**The Rejection Under
35 U.S.C. § 103**

Claims 1-24 and 40 have been rejected under 35 U.S.C. 103(a) as being unpatentable over what the Examiner characterized as Applicant's submitted state of the art in the specification on pages 1-3 in combination with either U.S. Patent No. 4,588,480 to Thoma, No. 4,938,850 to Rothschild et al., No. 5,603,338 to Beaty, No. 3,650,861 to Angell or No. 4,525,250 to Fahrmbacher-Lutz et al. Applicant respectfully traverses this rejection and submits the following arguments in support thereof.

Applicant's invention, as described in claim 1, involves a method of treating the surface of a substrate containing titanium for an ornament. This is done by providing the surface containing titanium, eliminating substances adhered to the substrate's surface from that surface, the adhered substances being foreign materials and resulting from the substrate having been subjected to machine working, and forming a transparent protective layer on the surface after removing the adhered substances.

Those skilled in the art will appreciate that examples of such machine working as described at page 24 of the specification include a honing process, a nicking process, or a mirror finishing process, and that any other process also could be used which can be said to have a decorative effect.

The present invention, through the steps of machine working, removing substances that adhere to the workpiece's surfaces, and then forming a transparent protective layer thereon, improves titanium or titanium alloy surfaces by making them more durable and resistant to scratches, fingerprints, corrosion and abrasion. Surface feel is also improved, making the objects more pleasant to the touch, and less likely to snag on or damage clothing. The specification **recognizes** these superior properties and gives numerous comparable examples

showing the superiority of the claimed invention relative to the prior art, for example, in Tables 6 and 7 and the accompanying discussion, at pages 28-33 of the specification. Applicant respectfully submits that such unexpectedly superior results constitute secondary indicia of non-obvious sufficient to establish the patentability of the claimed invention over the prior art.

In this regard, M.P.E.P. § 2141 states "[o]bjective evidence or secondary considerations such as unexpected results, commercial success, longfelt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence." In this regard, the Examiner is also directed to M.P.E.P. § 716.02, which recognizes (in the context of affidavit evidence) that proof of unexpected superior results can be sufficient to establish nonobviousness of an invention.

This rejection is further traversed on grounds that not all of the claimed steps have been shown to be taught by the cited art. It is stated at page 3 that the admitted state of the art teaches the use of titanium and titanium alloys to form watches with a transparent protective film, and that oxidation of such materials can be a problem.

The rejection then admits that the admitted state of the art "fails to teach removing 'adhesion substances' from the titanium surfaces prior to applying the transparent protective layer".

It is respectfully submitted that neither the admitted state of the art nor the applied references suggests at least the aspects of claim 1 relating to the removal of adhered substances on the workpiece's surface which are themselves a foreign materials resulting from the machine working of the substrate.

The remaining rejected claims, claims 3-24 and 40, all ultimately depend from and so incorporate by reference all the features of claim 1, including those features just shown to avoid the cited art. Claims 3-24 and 40 therefore avoid the cited art at least for the reasons which have been given with regard to base claim 1.

For all the foregoing reasons, favorable reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

Applicant respectfully submits that all outstanding rejections and objections have been addressed and are now either overcome or moot. Applicant further submits that all claims pending in this application are patentable over the prior art. Reconsideration and withdrawal of those rejections and objections is respectfully requested.

In view of the foregoing revisions and remarks, Applicant respectfully requests entry of this amendment and submits that entry of this amendment will place the present application in condition for allowance. It is further submitted that entry of this amendment can be approved by the Examiner consistent with Patent and Trademark Office practice, since the changes it makes should not require a substantial amount of additional work by the Examiner. It is believed that the changes presented in this amendment either address matters of form or issues that the Examiner has previously considered.

Applicant has made a diligent effort to place this application in condition for allowance and notice to the effect that claims 1-24 and 40 are in condition for allowance is earnestly solicited. Should, however, the Examiner deem otherwise, the Examiner is respectfully

requested to telephone the undersigned attorney at the number listed below to resolve any outstanding issues prior to issuing a further Office Action.

Respectfully submitted,



Lawrence Rosenthal
Registration No. 24,377
Attorney for Applicant
Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, New York 10038
(212) 806-5400

VERSION WITH MARKINGS TO SHOW CHANGES

IN THE CLAIMS:

Please cancel claim 2 without prejudice to or disclaimer of the subject matter presented therein.

Amend claim 1:

1. (Twice Amended) A method of treating a surface of a substrate containing titanium for an ornament, comprising the steps of:

providing the surface containing titanium;

eliminating substances adhered to said surface of said substrate from said surface,
said adhered substances resulting from the substrate having been subjected to machine working,
wherein said adhered substances are foreign materials, and

forming a transparent protective layer on said surface after removing said adhered substances.